

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board .

Paper No. 48

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

**MAILED**

**OCT 24 2001**

Ex parte ANTHONY MAGLICA

**PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Appeal No. 1997-3131  
Application No. 07/411,576

ON BRIEF

Before MCCANDLISH, Senior Administrative Patent Judge,  
STAAB and NASE, Administrative Patent Judges.

MCCANDLISH, Senior Administrative Patent Judge.

DECISION REGARDING ORDER TO SHOW CAUSE  
AND  
SECOND REMAND TO EXAMINER

On October 22, 1998, we issued an Order to appellant to show cause why the pending appeal should not be dismissed, and we accompanied that Order with a remand to the examiner (see Paper No. 43 remailed December 1, 1998).

The Order To Show Cause dealt with appellant's failure to address the new grounds of rejection added by the examiner in paragraphs a and b on page 2 of the advisory office action mailed November 12, 1996 (Paper No. 38) and reiterated on page 4 of his answer mailed February 21, 1997 (Paper No. 40). Both of the new grounds dealt with the examiner's rejection under 35 U.S.C. § 112, first paragraph. These new grounds also related to the examiner's refusal to grant appellant the benefit of the filing date of his first filed utility application under 35 U.S.C. § 120. As explained in our Order To Show Cause, these new grounds appear to have been prompted by the examiner's decision for non-apparent reasons to enter appellant's third amendment (Paper No. 36) filed on September 5, 1996 after the final office action (Paper No. 30).

In the remand proportion of our Order/Remand (Paper No. 43), we requested the examiner to identify the drawings as filed in the instant application. In addition, we requested the examiner to identify the drawings referred to on page 4 of the answer as the "original formal" drawings and, also, to identify the drawings referred to on page 4 of the answer as the "original mechanical" drawings. The

examiner was specifically requested to submit photocopies of the "original formal" drawings and the "original mechanical" drawing to us. Reference is made to pages 3-6 of our prior Order/Remand (Paper No. 43). As we noted in our prior Order/Remand (see particularly page 5 of Paper No. 43), there is conflicting evidence in the file about the drawings as originally filed in the instant application.

In light of our decision concerning the outstanding Order to Show Cause as set forth infra, this application is again remanded to the examiner pursuant to MPEP § 1211 (Seventh Edition Rev. 1, Feb. 2000) for the complying with the requests regarding the identification of drawings as summarized above and discussed in detail on pages 3-7 of our prior Order/Remand (Paper No. 43). As we noted in our prior Order/Remand (see, for example, page 4 of Paper No. 43), a clear identification of the drawings as originally filed in the instant application is of paramount importance for resolving the issues raised by the examiner's rejection under the first paragraph of § 112 and by the examiner's refusal to grant appellant the benefit of the filing date of his first filed utility application. On remand, the examiner is also called upon to confirm or correct our

understanding that the only sheet of drawings now pending in the instant application is the single sheet of drawings filed with the amendment of September 5, 1996 (Paper No. 36).

As noted on page 6 of our prior Order/Remand (Paper No. 43) and for reasons discussed at length on pages 5-7 of our prior Order/Remand (Paper No. 43), the application papers making up the instant application warrant a review by the examiner to determine if the instant application (which was filed as a so-called Rule 60 application) complies with the provisions of 37 CFR § 1.60 to be accorded a filing date pursuant to this rule as it existed at the time the instant application was filed.<sup>1</sup> As noted on page 6 of our prior Order/Remand (Paper No. 43), appellant's preliminary amendment filed concurrently with the instant application adds to the confusion about the drawings because it states that "three sheets of drawings," rather than one sheet of drawings, were submitted to replace the originally filed drawings.

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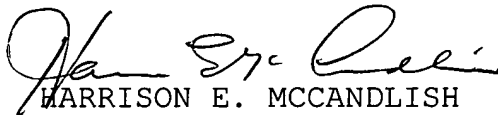
<sup>1</sup> The examiner may wish to consult with the Office of the Deputy Commissioner for Patent Examination Policy to determine if the instant application should be accorded a filing date pursuant to 37 CFR § 1.60 as this rule existed at the time that the instant application was filed.

With regard to our Order to Show Cause, we have carefully considered appellant's reply (Paper No. 45 filed November 11, 1999) and the examiner's remarks in the letter dated August 1, 2001 (Paper No. 47). As a result, we conclude that appellant has demonstrated sufficient cause to avoid dismissal of the current appeal. Accordingly, the appeal is maintained, and the examiner is called upon on remand under 37 CFR § 1.193(b)(1) to file a supplemental answer responding to the arguments set forth in appellant's reply (Paper No. 45), which we now treat as a supplemental brief, or take other appropriate action. Appellant may file a reply brief to the examiner's supplemental answer within TWO MONTHS from the date of the examiner's supplemental answer. See 37 CFR § 1.193(b)(1). Pursuant to this rule, 37 CFR § 1.136(b) governs time extensions for filing such a reply brief. Upon return of jurisdiction to this Board, the requested oral hearing will be rescheduled.

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution). This application, by virtue of its "special" status, requires immediate action. MPEP § 708.01.

REMANDED

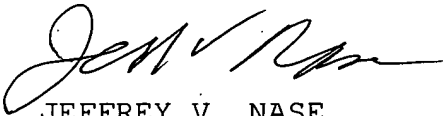
  
HARRISON E. MCCANDLISH

Senior Administrative Patent Judge )



LAWRENCE J. STAAB  
Administrative Patent Judge )

BOARD OF PATENT  
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JEFFREY V. NASE  
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